

REMARKS

In response to the Office Action dated March 28, 2003, claims 1, 8, 10, 12 and 18 are amended. Claims 1-21 are now active in this application. No new matter has been added.

A drawing correction is proposed for FIG. 12 to label as PRIOR ART. A separate paper requesting approval is submitted concurrently herewith.

CLAIM AMENDMENTS

Claims 1, 8, 12 and 18 are amended to correct a minor grammatical error, and claim 10 is amended to address the Examiner's objection that there is insufficient antecedent support for "second connectors" in line 2.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102

Claims 1-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Horikawa (USPN 4,930,896).

The rejections are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

There are significant differences between the claimed invention and the arrangement disclosed by Horikawa that scotch the factual determination that Horikawa identically describes the claimed inventions within.

Claim 1:

Horikawa does not disclose a "first displacement memory which stores a relative displacement between one photo-sensor and another photo-sensor in an incident direction", although the Examiner comments that it does at lines 6-8, page 3 of the present Office Action.

Horikawa is directed to an apparatus for measuring the surface structure of a sample of a certain shape without moving the apparatus by mechanical means. In order to implement this, Horikawa discloses an arrangement in which a user is notified of a displacement of a sample (denoted by numeral 96 in the embodiment of FIG. 11) relative to a focal point. Although not clearly disclosed in the embodiment shown in FIG. 11, the following measurement manner can be presumed based on the principle explained in association with FIGS. 6A through 6C.

Specifically, according to the principle based on FIGS. 6A through 6C, the construction shown in FIG. 11 splits or guides the light rays from the sample 96 into the two directions in the manner of a so-called pupil beam split by the mirror 101. Accordingly, when the sample shifts relative to the focal point, the incident position of the light rays from the sample on the position detectors 104 and 105 shifts relative to each other in a planar direction of the position detectors 104 and 105. In this way, the displacement or shift of the sample relative to the focal point is measured.

Horikawa, however, merely discloses that the sample-holding A/D converter circuit 114 stores a two-dimensional image in a frame memory 116 (see Col. 7 lines 26-27). Horikawa does not disclose that the frame memory 116 stores relative displacement of the position detectors 104, 105. Furthermore, if the above presumption regarding the light measuring principle shown in FIG. 11 is correct, relative displacement of the position detectors 104, 105 has no relevancy to relative displacement of the sample to the focal point, although the displacement in incident rays of light on the position sensors 104, 105 corresponds to the displacement of the sample to the focal point.

Claim 8:

Horikawa does not disclose a "first displacement memory which stores a relative displacement between one photo-sensor and another photo-sensor in an incident direction", as maintained above with regard to Applicants argument regarding the patentability of claim 1.

As mentioned above, Horikawa merely discloses that the sample-holding A/D converter circuit 114 stores a two-dimensional image in a frame memory 116 (see Col. 7 lines 26-27). Horikawa does not disclose that the frame memory 116 stores relative displacement of the position detectors 104, 105. Furthermore, if the above presumption regarding the light measuring principle shown in FIG. 11 is correct, relative displacement of the position detectors 104, 105 has no relevancy to relative displacement of the sample to the focal point, although the displacement in incident rays of light on the position sensors 104, 105 corresponds to the displacement of the sample to the focal point.

Claim 12:

Horikawa does not disclose a "first displacement memory which stores a relative displacement between one photo-sensor and another photo-sensor in an incident direction", as maintained above with regard to Applicants arguments regarding the patentability of claims 1 and 8.

As mentioned above, Horikawa merely discloses that the sample-holding A/D converter circuit 114 stores a two-dimensional image in a frame memory 116 (see Col. 7 lines 26-27). Horikawa does not disclose that the frame memory 116 stores relative displacement of the position detectors 104, 105. Furthermore, if the above presumption regarding the light measuring principle shown in FIG. 11 is correct, relative displacement of the position detectors 104, 105 has no relevancy to relative displacement of the sample to the focal point, although the displacement in incident rays of light on the position sensors 104, 105 corresponds to the displacement of the sample to the focal point.

In addition, Horikawa does not disclose the recited two modes (first measurement mode and second measurement mode).

Claim 18:

Horikawa does not recite "first displacement memory which stores a relative displacement between one photo-sensor and another photo-sensor in an incident direction", as maintained above with regard to Applicants arguments regarding the patentability of claims 1, 8 and 12

As mentioned above, Horikawa merely recites that the sample-holding A/D converter circuit 114 stores a two-dimensional image in a frame memory 116 (see Col. 7

lines 26-27). Horikawa does not disclose that the frame memory 116 stores relative displacement of the position detectors 104, 105. Furthermore, if the above presumption regarding the light measuring principle shown in FIG. 11 is correct, relative displacement of the position detectors 104, 105 has not relevancy to relative displacement of the sample to the focal point, although the displacement in incident rays of light on the position sensors 104, 105 corresponds to the displacement of the sample to the focal point.

In addition, Horikawa does not disclose the recited two modes (first measurement mode and second measurement mode).

The above argued differences between the claimed device vis-à-vis the device of Horikawa, undermine the factual determination that Horikawa identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicants, therefore, submit that the imposed rejection of independent claims 1, 8, 12 and 18, as well as dependent claims 2-7, 9-11, 13-17 and 19-21 under 35 U.S.C. § 102 for lack of novelty, as evidenced by Horikawa, is not factually or legally viable and, hence, solicit withdrawal thereof. Consequently, the allowance of claims 1-21 is respectfully solicited also.

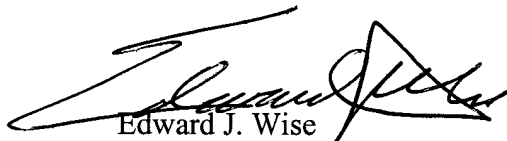
CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY


Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW:khh
Facsimile: (202) 756-8087
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